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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/659,683	09/11/00	PAIEL	R 07164.0004-0

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FINNEGAN HENDERSON FARABOW GARRETT AND D  
1300 I STREET N W  
WASHINGTON DC 20005-3315

EXAMINER

WRIGHT, S

ART UNIT

PAPER NUMBER

1626

DATE MAILED:

01/30/01

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.

09/659,683

Applicant(s)

Patel

Examiner

Sonya Wright

Group Art Unit

1626



☐ Responsive to communication(s) filed on \_\_\_\_\_

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1035 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 1 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claim

☒ Claim(s) 1-26 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☐ Claim(s) \_\_\_\_\_ is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☒ Claims 1-26 are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☒ None of the CERTIFIED copies of the priority documents have been received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

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### DETAILED ACTION

Claims 1-26 are pending in this application.

#### *Election/Restriction*

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-11, drawn to a process, classified in class 548, subclass 229.
- II. Claim 12, drawn to a process, classified in class 548, subclass 229.
- III. Claim 13, drawn to a compound, classified in class 548, subclass 229.
- IV. Claims 14-16 and 22-24 drawn to intermediates, classified in classes 560/22+, and 564/ 374.
- V. Claims 17 and 25 drawn to an intermediate, classified in class 548, subclass 229.
- VI. Claims 18-20, drawn to processses, classified in class 560/22+, 564/374.
- VII. Claim 21, drawn to a process, classified in class 548, subclass 229.
- VIII. Claim 26, drawn to a composition, classified in classes 560/22+, and 564/374.

Applicants should note that claims 22-26 contain nonstatutory language and applicant's intent is unclear.

Groups I, II, VI, and VII are distinct, each from the other, because they are drawn to different processes, involving different reactive steps and conditions. Each process is distinct from one another and is capable of supporting their own patent(s).

Groups III and IV, and III and V are related as mutually exclusive species in an intermediate-final product relationship. Distinctness is proven for claims in this relationship if the

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intermediate product is useful to make other than the final product (MPEP § 806.04(b), 3rd paragraph), and the species are patentably distinct (MPEP § 806.04(h)). In the instant case, the intermediate product is deemed to be useful in the preparation of substituted indole derivatives and the inventions are deemed patentably distinct since there is nothing on this record to show them to be obvious variants. Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions anticipated by the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

During a telephone conversation with Mr. Eyal H. Barash on January 22, 2001, the examiner requested an oral election to the above restriction requirement, but this did not result in an election being made.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sonya Wright whose telephone number is (703) 308-4539. The examiner can normally be reached on Monday through Thursday and on alternate Fridays from 7:30 to 5:00.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph K. McKane, can be reached on (703) 308-4537. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-4556.

When filing a FAX in Technology Center 1600, please indicate in the Header (upper right) "Official" for papers that are to be entered into the file, and "Unofficial" for draft documents and other communications with the PTO that are not for entry into the file of the application. This will expedite processing of your papers.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1235.

A handwritten signature in cursive script, reading "Joseph K. McKane", is written over a horizontal line.

Joseph K. McKane

Supervisory Patent Examiner

Group 1600

Sonya Wright

January 29, 2001